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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO. |
| 09/783,185   | 02/14/2001  | Yoichiro Igarashi    | FUJO 18.314                     | 2123             |
| 26304 7590 05/27/2008<br>KATTEN MUCHIN ROSENMAN LLP<br>575 MADISON AVENUE<br>NEW YORK, NY 10022-2585 |             |                      | EXAMINER<br>ISMAIL, SHAWKI SAIF |                  |
|  |             |                      | ART UNIT                        | PAPER NUMBER     |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/783,185

**Applicant(s)**

IGARASHI ET AL.

**Examiner**

SHAWKI S. ISMAIL

**Art Unit**

2155

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **RESPONSE TO AMENDMENT**

1. This communication is responsive to the amendment received on March 11, 2008.  
Claims 1-2, 4-8 and 11-15 have been amended.  
Claims 1-15 are pending.

#### **Continued Examination Under 37 CFR 1.114 1**

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 11, 2008 has been entered.

#### **The New Grounds of Rejection**

3. Applicant's amendment and arguments received on March 11, 2008 have been fully considered, however they are deemed to be moot in view of the new grounds of rejection.

#### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Morin et al.**, (referred hereinafter as Morin) U.S. Patent No. **6,584,312** in view of **Cunningham et al.**, (referred hereinafter as Cunningham) U.S. Patent No. **6,453,174**.

Morin teaches the invention explicitly as claimed including a system and method for registering mobile devices with a home agent and updating the device registry and updates the registry table to reflect roaming of the node from a first HA to a second HA (see abstract).

6. As to claim 1, Morin teaches a mobile communications service providing system in which location registration request information is transmitted from a mobile node to a home agent via a foreign agent and a server system, and information in reply to the location registration request information is returned from the home agent to the mobile node via the server system and the foreign agent, so that a location of the mobile node is registered to the home agent and the foreign agent, and a mobile communications service is provided based on the registration, wherein:

the server system comprising:

an extracting unit extracting a service profile corresponding to the mobile node described in a first format from a database for managing the first service profile which includes subscriber information of each user (see fig. 4 and col. 5, lines 1-17, the subscriber profile is retrieved),

a service managing unit editing the first service profile extracted by said extracting unit which includes control information for transmitting a packet that the mobile node communicates using a communication path established after completing of the location registration and the format remaining the same irrespective to the kind of service provided to a user (see fig. 4 and col. 5 lines 1-35, the subscriber profile is modified), and

a distributing unit distributing the edited service profile to the home agent and the foreign agent (see fig. 4, col. 5, lines 40-57, the modified subscriber profile is transmitted), and

the home agent and the foreign agent comprising:

a controlling unit determining transfer destination of a packet according to the distributed information of the edited service profile (see fig. 4, col. 5, lines 40-57, service is provided based on the edited service profile), and

the home agent and the foreign agent provide a service by using said controlling unit according to the edited service profile distributed from the server system (see fig. 4, col. 5, lines 40-57, the service provided is in accordance with the edited service profile).

Morin does not explicitly teach wherein the service managing unit editing the service profile to obtain the same service profile described in a second format.

Cunningham teaches a roaming interworking gateway for interworking of at least two mobile telecommunication systems having non-compatible standards, the gateway comprising: a modular unit associated with a first mobile system and comprising a pseudo network element of the first system; a modular unit associated with a second mobile system and comprising a pseudo network element for the second system; and an interworking translation function linking the modular units and comprising means for performing data and protocol conversion between the units (Cunningham, col. 1, lines 52-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a subscriber profile translator that translates or converts a subscriber profile from one format into another format compatible with either the home or foreign agent receiving the subscriber profile as taught by Cunningham into the system of Morin, because both

Morin and Cunningham are from the same field of endeavor of handling subscriber profile information during roaming from one area or network to another and by enabling translation of the subscriber profile into a format compatible with either a home agent or a foreign agent gives the user the flexibility to roam from one network to another non-compatible network while allowing them to preserve, when possible, supplementary services between networks (Cunningham, col. 1, lines 37-50).

7. As to claim 2, Morin teaches the system according to claim 1, wherein

the server system does not distribute the edited service profile to the home agent and the foreign agent, if the mobile node does not request a value-added service, and the home agent and the foreign agent provide a fundamental service according to information that the home agent and the foreign agent themselves generate (col. 5, lines 36-39).

8. As to claim 3, Morin teaches the system according to claim 1, wherein:

an address range available for a predetermined service is specified beforehand; a service profile including information representing the address range which is specified beforehand is set in the home agent and the foreign agent as a condition for extracting a corresponding packet from among received packets; and the server system assigns an address within the address range to the mobile node that requests the predetermined service (see fig. 4 and col. 5 lines 1-35).

9. As to claim 4, Morin teaches the system according to claim 1, wherein:

the server system includes a home server device which has a right to access the database in order to extract the first service profile for the mobile node, and a foreign server device which does not have such an access right (see fig. 4 and col. 5, lines 1-17); and

the home server device distributes the edited service second profile to the home agent and the foreign server device, and the foreign server device forwards the edited service profile to the foreign agent (see fig. 4, col. 5, lines 40-57).

10. As to claim 5, Morin teaches the system according to claim 1, wherein:

the server system includes a home server device which has a right to access the database in order to extract the first service profile for the mobile node, and a foreign server device which does not have such an access right (see fig. 4 and col. 5, lines 1-17); and

the home server device distributes the edited service profile to the foreign server device, and the foreign server device forwards the edited service profile to the home agent and the foreign agent (see fig. 4, col. 5, lines 40-57).

11. As to claim 6, Morin teaches the system according to claim 1, wherein:

the server system includes a home server device which has a right to access the database in order to extract the service profile for the mobile node, and a foreign server device which does not have such an access right (see fig. 4 and col. 5, lines 1-17);

the mobile node notifies the home agent of location registration request information via a second foreign agent when moving from a communication area of a first foreign agent to a communication area of the second foreign agent (see fig. 4, col. 5, lines 40-57);

the home agent updates information for routing a packet so that a packet addressed to the mobile node is transferred to the second foreign agent (see fig. 4, col. 5, lines 40-57); and

the foreign server device distributes the edited service profile to the second foreign agent (see fig. 4, col. 5, lines 40-57)

12. As to claim 7, Morin teaches the system according to claim 1, wherein:

the server system includes a home server device which has a right to access the database in order to extract the service profile for the mobile node, and first and second foreign server devices which do not have such an access right (see fig. 4 and col. 5, lines 1-17);

the mobile node notifies the home agent of location registration request information via a second foreign agent, the second foreign server device, and the home server device when moving from a communication area of a first foreign agent managed by the first foreign server device to a communication area of the second foreign agent managed by the second foreign server device (see fig. 4 and col. 5 lines 1-35);

the home agent updates information for routing a packet so that a packet addressed to the mobile node is transferred to the second foreign agent (see fig. 4, col. 5, lines 40-57); and

the home server device distributes the edited service profile to the second foreign server device, which then forwards the edited service profile to the second foreign agent (see fig. 4, col. 5, lines 40-57).

13. As to claim 8, Morin teaches the system according to claim 1, wherein:

the server system includes a home server device which has a right to access the database in order to extract a service profile for the mobile node, and first and second foreign server devices which do not have such an access right(see fig. 4 and col. 5 lines 1-17);

the mobile node notifies the home agent of location registration request information via a second foreign agent, the second foreign server device, the home server device, and the first foreign server device when moving from a communication area of a first foreign agent managed by the first foreign server device to a communication area of the second foreign agent managed by the second foreign server device ((see fig. 4 and col. 5, lines 1-35);



the home agent updates information for routing a packet so that a packet addressed to the mobile node is transferred to the second foreign agent (see fig. 4, col. 5, lines 40-57); and

the home server device distributes the edited service profile to the second foreign server device, which then forwards the service profile to the second foreign agent (see fig. 4, col. 5, lines 40-57).

14. As to claim 9, Morin teaches the system according to claim 1, wherein:

upon receipt of the packet addressed to the mobile node from a correspondent node, the home agent distributes to the correspondent node a service profile for extracting a packet in which the mobile node is set as a destination (see fig. 4 and col. 5, lines 1-17); and

the correspondent node generates information for transmitting to the foreign agent a packet which is extracted according to the distributed service profile (see fig. 4 and col. 5 lines 1-35).

15. As to claim 10, Morin teaches the system according to claim 1, wherein

when providing a service for transferring to an arbitrary mobile node among a plurality of mobile nodes a packet with a virtual address assigned to the plurality of mobile nodes as a destination:

an address proxy server receiving the packet with the virtual address is arranged (see fig. 4 and col. 5, lines 1-17); and

the server system distributes to said address proxy server a service profile for extracting the packet with the virtual address is assigned and transferring the extracted packet to the particular mobile node among the plurality of mobile nodes, and also distributes to a foreign

agent a service profile for transferring to the particular mobile node a packet addressed to the foreign agent which accommodates the particular mobile node (see fig. 4, col. 5, lines 40-57).

16. Claims 11-15 do not teach or define any new limitations above claims 1-10, therefore, they are rejected for similar reasons.

17. Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### Response to Arguments

18. Applicant's amendment and arguments received on March 11, 2008 have been fully considered, however they are deemed to be moot in view of the new grounds of rejection.

### Contact Information

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawki S. Ismail whose telephone number is 571-272-3985. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2155

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shawki S Ismail/  
Examiner, Art Unit 2155  
May 22, 2008